

## REMARKS

Claims 21, 23, 25-37, 42 and 43 are pending in the application. Applicants respectfully request reconsideration in light of the following remarks.

1. **Rejection of claims 21, 27-31 and 33-37 under 35 U.S.C. §102(a) as anticipated by WO 00/15725, hereafter “‘725”.**

The Undersigned notes that Applicants' foreign priority date render the instant rejection moot. The PTO's acknowledgement of the receipt of the certified copies of the priority documents is appreciated.

A copy of the translation of the certified priority document is being concurrently submitted under separate cover per MPEP 201.15 and 37 CFR 1.55 (a) (4). It is expected that upon the filing of the translation, Applicants will be entitled to rely upon the priority date to overcome the cited reference. Applicants regret the inadvertent delay in making this submission.

2. **Rejection of claims 21 and 27-31 under 35 U.S.C. §102(b) as anticipated by GB 778924, hereafter “‘924”.**

Applicants respectfully assert that '924 fails to disclose each and every element of the pending claims. To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

'924 fails to disclose the instantly claimed polydispersity (Mw/Mn) of 1.3 to 10. '924 at best merely suggests the inclusion of 3,6-diethyl-1,8-octane diol in polyesters and polyurethanes. '924 is silent with regard to the actual properties of these polymers and does not teach or suggest a polydispersity as instantly claimed. Applicants additionally note that missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Furthermore, Applicants assert that there is insufficient information to support an anticipation rejection based on inherency because in order to support an anticipation

rejection based on inherency, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). Given the fact that the prior art merely suggests the inclusion of 3,6-diethyl-1,8-octane diol in polyesters and polyurethanes Applicants believe there is insufficient information in the cited reference for the claimed polydispersity to necessarily flow from the teachings of '924.

**3. Rejection of claims 21, 23, 25-37, 42, and 43 under 35 U.S.C. §102(a) as anticipated by Bartol, EP 9490459, hereafter "459".**

The Undersigned notes that Applicants' foreign priority date render the instant rejection moot. The PTO's acknowledgement of the receipt of the certified copies of the priority documents is appreciated.

A copy of the translation of the certified priority document is being concurrently submitted under separate cover per MPEP 201.15 and 37 CFR 1.55 (a) (4). It is expected that upon the filing of the translation, Applicants will be entitled to rely upon the priority date to overcome the cited reference. Applicants regret the inadvertent delay in making this submission.

**4. Rejection of claims 21, 23, 25-37, 42, and 43 under 35 U.S.C. §103(a) as unpatentable over "725", "924", or "459".**

The rejections under 35 U.S.C. §103(a) over "725" and "459" are overcome by the Applicants' foreign priority date.

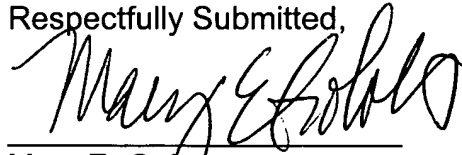
With regard to the rejection under 35 U.S.C. §103(a) over "924" Applicants respectfully note that for an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In*

*Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). As explained above with regard to the rejection under 35 U.S.C. §102(b), '924 does not contain all elements of the pending claims and, as a result, does not provide sufficient basis for a prima facie case of obviousness.

## CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



Mary E. Golota  
Registration No. 36,814  
Cantor Colburn LLP  
(248) 524-2300

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### CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION  
1609 Biddle Avenue  
WYANDOTTE, MI 48192  
Customer No. 26922